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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,262	02/14/2000	Linda McMeekin	JBP-480	6305

7590 04/14/2003

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EXAMINER

WALCZAK, DAVID J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 04/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/503,262

Applicant(s)

MCMEEKIN ET AL.

Examiner

David J. Walczak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-11, 13, 15, 18 and 20-46 is/are pending in the application.
- 4a) Of the above claim(s) 8, 12, 14, 16, 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 13, 15, 18, 22, 24-27, 29 and 33 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 10, 20, 21, 23, 28, 30-32 and 34-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: There is no "Brief Description" of new Figures 15-20. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 2, 13 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 2, this claim is indefinite in that all of the various materials are defined as being used in one film, i.e., it appears that this claim should be redrafted such that any one of the various materials listed therein are used to make the film. In regard to claim 13, this claim is indefinite in that it depends from canceled claim 12. In regard to claim 27, an antecedent basis for "the open area" of the first and second sides should be defined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3, 11, 15, 18, 22 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Hochbrueckner. In regard to claim 1, Hochbrueckner discloses a device comprised of a piece of "gathered" three-dimensional textured film (column 4, lines 17, 25, as various pieces of film are stitched together, the assembled film is considered to be "gathered") and a securing means (the stitching) for holding the film together. In regard to claim 3, textured film inherently has embossments thereon. In regard to claim 11, the device includes an inner substrate 10 that is substantially covered by the film. In regard to claim 15, the inner substrate is a non-sheetlike three dimensional body. In regard to claim 18, substrate 10 defines a holding means. In regard to claim 22, the method as claimed is inherent in the assembling of the device discussed above. In regard to claims 24-26, the film defines a "textured film pad" attached to a holding means 10 which inherently has protuberances (since the film is textured) on at least the first side.

Claims 1-4, 18, 22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Tanquary et al. (hereinafter Tanquary). In regard to claim 1, Tanquary

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discloses a "gathered" three-dimensional textured film 102 (as the film is formed into a tube, it is considered to be "gathered") and a securing means 105 for holding the gathered film together. In regard to claim 2, the device is made from the claimed material(s) (see column 20). In regard to claim 3, the film has embossments thereon (see Figures 18-20 and column 20, lines 27-32). In regard to claim 4, the embossments have a depth of "about" 0mm to "about" 3mm. In regard to claim 18, any portion of the film which can be grasped is a "holding means". In regard to claim 22, the method as claimed is inherent in the forming of the device discussed supra. In regard to claim 24, the film is in the form of a cloth having at least 1.3 variations/cm² (it actually has from 1000 to 100,000 variations/in², which is much more than claimed). In regard to claims 25 and 26, one of the sides has outward protrusions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hochbrueckner. Although the Hochbrueckner reference does not disclose the specifically claimed materials are used to make the film, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the

invention was made that any suitable plastic material (including those claimed) can be used to make the film without effecting the overall operation of the device.

Claims 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanquary in view of Kelly. Although the Tanquary device is not disclosed as being coated with an active material, attention is directed to the Kelly reference, which discloses another condom wherein the condom is coated with an active material in order to render the device safer to use. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to coat the Tanquary device with such an active material in order to render the device safer to use.

Allowable Subject Matter

Claims 13 and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


Claims 5-7, 9, 10, 20, 21, 23, 28, 30-32 and 34-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
April 10, 2003